

RECEIVED
CENTRAL FAX CENTER
JUN 10 2005

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL
FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 18

Application Number	10/716,637
Filing Date	November 18, 2003
First Named Inventor	Cooper
Art Unit	3821
Examiner Name	Bayat, Bradley B. (formerly, Hayes, John W.)
Attorney Docket Number	JDC-002-US

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks This application was being handled by Examiner Hayes. However, the PAIR database now indicates that Examiner Bayat is handling the application. This amended appeal brief is being submitted in response to a Notification of Non-Compliant Appeal Brief. No fee is due.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Rosenfeld Law Corporation		
Signature	/Mitchell S. Rosenfeld/		
Printed name	Mitchell S. Rosenfeld		
Date	April 8, 2005	Reg. No.	36,258

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	/Mitchell S. Rosenfeld/		
Typed or printed name	Mitchell S. Rosenfeld	Date	June 8, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER 02
JUN 10 2005

Attorney Docket No. JDC-002-US

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: JONATHAN D. COOPER
APPLICATION No.: 10/716,637
FILED: NOVEMBER 18, 2003
FOR: IMPROVED MONEY TRANSFER SYSTEM AND
METHOD WITH ADDED SECURITY FEATURES

EXAMINER: BAYAT, BRADLEY B.
(FORMERLY HAYES, JOHN
W.)
ART UNIT: 3621

APPEAL BRIEF (amended)

Dear Sir:

In response to the Final Office Action mailed November 8, 2004, Applicant submitted a Notice of Appeal on February 8, 2005 and Appeal Brief on April 8, 2005. The Appeal Brief was submitted within the statutory time of two (2) months from the Notice of Appeal along with the required fee of \$250.

In response to a Notification of Non-Compliant Appeal Brief mailed on June 3, 2005, Applicant submits this amended Appeal Brief.

I. REAL PARTY IN INTEREST

The real party in interest is the inventor, Jonathan Cooper.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Presently, claims 1-58 are cancelled, and claims 59-75 are rejected.

Claims 59-75 were rejected in the Final Office Action mailed November 8, 2004. The pending claims are attached hereto as an Appendix. All pending claims – claims 59-75 – are appealed.

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 2 of 17

IV. STATUS OF AMENDMENTS

Claims 1-58 were filed in the pending application, which is a continuation of U.S. Appl. No. 09/648,102 filed August 25, 2000. A preliminary amendment was filed November 18, 2003, which cancelled claims 1-58 and added claims 59-75. The first Office Action was mailed July 12, 2004. An Amendment in response to the first Office Action was filed August 25, 2004. In response to the Amendment, a second Office Action was mailed November 8, 2004 rejecting the pending claims for the second time. The second Office Action was a Final rejection. A Notice of Appeal was filed on February 8, 2005. No Amendments are pending.

V. SUMMARY OF INVENTION

The independent claims involved in the appeal are claims 59, 64, 68 and 73. None of the independent claims are subject to 35 U.S.C. §112, ¶6. The subject matter defined in each independent claim is summarized below. Although the claims are not limited to or by the embodiments described in the specification and drawings, the summaries below include cross-references to an exemplary embodiment falling within the scope of the claims.

A. Summary of Claim 59

The invention described in claim 59 is directed to an automated process for sending money from a first location to a second location. (see generally, figure 5) The process includes receiving a request for a secure money transfer from a requestor 502 (see spec at ¶50, lines 1-6; ¶60, lines 1-3); receiving information associated with a recipient 504 for said secure money transfer (see spec at ¶51, lines 1-4; ¶60, lines 3-6); receiving information indicating an amount of said secure money transfer (see spec at ¶50, lines 6-8; ¶60, lines 3-6); transferring the amount to a standard atm card 512 (see spec at ¶53, lines 1-6; ¶61, lines 1-7); assigning an access code 514 to the standard atm card 512 (see spec at ¶51, lines 6-7; ¶53, lines 1-5; ¶61, lines 1-7); providing the standard atm card 512 to the recipient 504 (see spec at ¶54, lines 1-4); and providing the access code 514 from the requestor 502 to the recipient 504 (see spec at ¶52, lines 1-4; ¶57, lines 3-5). The standard atm card 512 is a card for use in existing automated teller machines 526. (see spec at ¶57, lines 1-3) The standard atm card 512 and the access code 514 enable the recipient 504 to use the standard atm card 512 in the automated teller machines 526. (see spec at ¶57, lines 1-5)

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 3 of 17

B. Summary of Claim 64

The invention described in claim 64 is directed to an automated process for sending money from a first location to a second location. (see generally, figure 5) The process includes receiving a request for a secure money transfer from a requestor 502 indicating a destination for the transfer and an amount for transfer via a communications network 507 (see spec at ¶50, lines 1-8; ¶60, lines 1-6); assigning the amount to a standard atm card 512 (see spec at ¶53, lines 1-6; ¶61, lines 1-7); assigning an access code 514 to the standard atm card 512 (see spec at ¶51, lines 6-7; ¶53, lines 1-5; ¶61, lines 1-7); providing the access code 514 from the requestor 502 to the recipient 504 (see spec at ¶52, lines 1-4; ¶57, lines 3-5); and providing the standard atm card 512 to the destination such that a recipient 504 receives the standard atm card enabling the recipient 504 to withdraw funds from an automated teller machine 526 using the standard atm card 512 and the access code 514 where the additional amounts may be assigned to the standard atm card 512 by the requestor 502 for retrieval by the recipient 504 (see spec at ¶54, lines 1-4; ¶57, lines 1-5).

C. Summary of Claim 68

The invention described in claim 68 is directed to an automatic money transfer system for transferring money from a donor 502 to a donee 504. (see generally, figure 5) The system 500 includes an automated server system 506/510 for facilitating the secure transfer of money from a donor 502 to a donee 504, the automated server system 506/510 being operative to allocate funds to a standard atm card and to assign a security code 514 to the instrument 512, the standard atm card 512 including machine readable information (see spec at ¶¶50-51); a data storage device 508 for recording the secure transfer (see spec at ¶51, lines 1-7); and a delivery system 516 for providing the standard atm card 512 to the donee 504 enabling the donee 504 to access the funds from an existing automated teller machine 526 using the standard atm card 512 and the security code 514 (see spec at ¶54, lines 1-4; ¶57, lines 1-5). The donor 502 provides the security code 514 to the donee 504. (see spec at ¶52, lines 1-4; ¶57, lines 3-5)

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 4 of 17

D. Summary of Claim 73

The invention described in claim 73 is directed to an automated process for sending money from a first location to a second location. (see generally, figure 5) The process includes receiving a request for a secure money transfer from a requestor 502 (see spec at ¶50, lines 1-6; ¶60, lines 1-3); receiving information associated with a recipient 504 for said secure money transfer (see spec at ¶51, lines 1-4; ¶60, lines 3-6); receiving information indicating an amount of said secure money transfer (see spec at ¶50, lines 6-8; ¶60, lines 3-6); transferring the amount to a standard atm card 512 (see spec at ¶53, lines 1-6; ¶61, lines 1-7); assigning an access code 514 to the standard atm card 512 (see spec at ¶51, lines 6-7; ¶53, lines 1-5; ¶61, lines 1-7); providing the standard atm card 512 to the recipient 504 at an address personal to said recipient (see spec at ¶54, lines 1-4); and providing the access code 514 from the requestor 502 to the recipient 504 (see spec at ¶52, lines 1-4; ¶57, lines 3-5). The standard atm card 512 is a card for use in existing automated teller machines 526. (see spec at ¶57, lines 1-3) The standard atm card 512 and the access code 514 enable the recipient 504 to use the standard atm card 512 in the automated teller machines 526. (see spec at ¶57, lines 1-5)

VI. ISSUES

A. Whether the Examiner has met the burden of proving that claims 59, 61, 68-70, 72-73, and 75 are obvious in view of Downing (U.S. Patent No. 5,963,647) and Picciallo (U.S. Pat. No. 6,044,360).

B. Whether the Examiner has met the burden of proving that claims 60, 71, and 74 are obvious in view of Downing, Picciallo, and Ito (U.S. Patent No. 6,039,250).

C. Whether the Examiner has met the burden of proving that claims 62-66 are obvious in view of Downing, Picciallo, and Corder (U.S. Pat. No. 5,936,221).

D. Whether the Examiner has met the burden of proving that claim 67 is obvious in view of Downing, Picciallo, Corder, and Ito.

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 5 of 17

VII. GROUPING OF CLAIMS

- A. Claims 59, 61, 68-70, 72-73, and 75 stand or fall together.
- B. Claims 60, 71, and 74 stand or fall together.
- C. Claims 62-66 stand or fall together.
- D. Claims 67 stands or falls alone.

VIII. ARGUMENT

A. Summary

In the Final Office Action mailed November 8, 2004, claims 59, 61, 68-70, 72-73, and 75 are rejected under 35 U.S.C. §103(a) as being unpatentable over Downing in view of Picciallo. Claims 60, 71, and 74 are rejected under 35 U.S.C. §103(a) as being unpatentable over Downing and Picciallo further in view of Ito. Claims 62-66 are rejected under 35 U.S.C. §103(a) as being unpatentable over Downing and Picciallo further in view of Corder. Claim 67 is rejected under 35 U.S.C. §103(a) as being unpatentable over Downing in view of Picciallo and Corder and further in view of Ito. Applicant respectfully submits that the claimed features are not fairly taught or suggested by the references and that no motivation exists to combine the references as suggested by the Examiner.

B. Prior Art

1. Downing

Downing is directed to a system and method that support funds transfers from a source account to a cash access file for *cardless withdrawal* by both customers and non-customers of a particular financial institution. *Downing* at col. 3, lines 40-47.

Downing does NOT in anyway teach a mechanism for providing ATM cards to the recipient of a money transfer transaction. In fact, the goal of Downing is to provide for money transfers without the use of an ATM card by the recipient. This is also made clear by Downing proclamation that "it is an object of the invention to provide a system and method which support funds transfers from a source account to a cash access file for *cardless withdrawal* by both customers and non-customers of a particular financial institution." *Downing* at col. 3, 42-47 (emphasis added). Additionally, Downing states that "transfers made in accordance with the invention may be understood functionally as an 'electronic check' where the sender remains the

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 6 of 17

'owner' of the funds until they are picked up by the recipient. *Id.*, at col. 7, lines 60-63. Because of this fundamental goal of Downing, "settlement does not take place until the funds are actually withdrawn by the recipient." *Id.*, at col. 7, lines 53-54.

Additionally, Downing at col. 9, teaches a fund transfer procedure "without inputting a PIN and card in the conventional manner." *Downing* at col. 12, lines 16-18. This recited method of Downing not only fails to teach use of a computer readable medium, but also teaches away from use of a computer readable medium given that the Downing method is designed to eliminate use of a "PIN and card."

In sum, Downing teaches recipients can only receive transferred funds one of two ways: 1) by having an account and ATM card at the same financial institution as the sender, and 2) using a specially configured terminal (CAT) to enter verification information without the use of an ATM card.

These characteristics of Downing demonstrate that its teachings are far a field from that which is recited in all of the claims of the present application.

2. Picciallo

Picciallo is directed to transferring funds from a pre-established account to a third party recipient in a manner that allows control and tracking by the sender over the spending by the recipient. *Picciallo* at col. 1, lines 12-19. An object of Picciallo is to provide the sender of the funds with an itemized statement of how recipients spend the funds. *Id.*, at col. 2, lines 17-22. A further object is to allow the sender to set limits on the goods and services for which the funds are spent, or on the amounts which may be spent for certain goods or services. *Id.*, at col. 2, lines 23-28. In part, this is accomplished by transferring the funds to a secondary file. As such, the funds are still under the control of the sender.

3. Itoh

Itoh is directed to an electronic money sending system which send and receives money between IC cards where the systems stores electronic money that is being transferred until a convenient time for the receiver to retrieve the electronic money. *Itoh* at col. 1, lines 9-46. Additionally, Itoh teaches providing a refund after "a certain period of time passes." *Id.*, at col. 2, lines 42-47; col. 5, line 65 to col. 6, line 3. Itoh focuses on the transfer of the electronic money,

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 7 of 17

not the IC card which is presumed to already be in the recipient's possession. *See e.g., id.*, at figs. 1-3.

4. Corder

Corder is directed to a smart card system and a method for transferring value to the smart card so that customers can use self service machines, such as laundry and vending machines, without requiring cash. The customer utilizes a central server and value added terminal to add cash value to the smart card. *Corder* at col. 1, lines 5-8; col. 2, lines 2-39.

C. The Examiner Has Failed To Demonstrate A *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* §2143.

The *MPEP* is very helpful in analyzing the first criteria -- motivation to combine. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *MPEP* §2143.01.

One particularly relevant example from the *MPEP* the absence of a motivation to combine references occurs when the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified. *MPEP* §2143.01. In such an event, the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Additionally, the question of obviousness under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 8 of 17

a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece."). Likewise, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

Here, the references relied upon by the Examiner fail to satisfy any of the three criteria to establish *prima facie* obviousness. First, there is no motivation found within the references to combine them in the manner suggested by the Examiner. This is demonstrated by the Examiner having proposed a modification or combination of the prior art would change the principle of operation of the prior art invention being modified. Further, the Examiner has failed to view both the invention and the prior art as a whole. In fact, the primary reference, Downing, teaches away from the suggested combination. Second, there is no reasonable likelihood of success. Third, the references do not teach each and every element of the group 2 and group 4 claims. Consequently, Applicant requests that the Board overturn the Examiner's rejections as described below with respect to the pending claims.

1. ISSUE A: Group 1 (claims 59, 61, 68-70, 72-73, and 75) are non-obvious in view of Downing and Picciallo.

Claim 59 states:

59. (Previously presented) An automated process for sending money from a first location to a second location comprising:
receiving a request for a secure money transfer from a requestor;
receiving information associated with a recipient for said secure money transfer;
receiving information indicating an amount of said secure money transfer;
transferring said amount to a standard atm card;
assigning an access code to said standard atm card;
providing said standard atm card to said recipient; and
providing said access code from said requestor to said recipient;
wherein said standard atm card is a card for use in existing automated teller machines; and
whereby said standard atm card and said access code enable said recipient to use said standard atm card in said automated teller machines.

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 9 of 17

The Examiner asserts that the group 1 claims are obvious in view of Downing in view of Picciallo. The Examiner states that Downing "fails to explicitly disclose the use of a standard atm card configured to enable the completion of the secure money transfer and wherein the computer readable medium is delivered to the recipient consumer." To cure this deficiency in Downing, the Examiner further states that "Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds from a sender to a recipient and further teaches that a computer readable medium such as an atm card is configured to enable the completion of the secure money transfer using atm machines...." Office Action dated November 8, 2004 at p.3. As for a motivation to combine, the Examiner does not point to any teaching in the references. Rather, the Examiner states that "these mediums are so well known and devices that accept these forms of mediums are also readily available." *Id.*

The facts alleged by the Examiner fails to provide a sufficient motivation to combine the references. Simply because ATM cards and machines were well known teaches nothing as to why one of ordinary skill in the art would depart from the principle teaching of Downing, namely cardless cash withdrawal.

The failure of the Examiner to identify a proper motivation is not surprising given the extent of the modifications to the primary reference, Downing, suggested by the Examiner. The suggested combination would require adding a standard ATM card to a primary reference which has a stated goal of eliminating the use of a standard ATM card. The suggested combination is strikingly similar to *In re Ratti* where the court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." *In re Ratti*, 270 F.2d at 813, 123 USPQ at 352.

The lack of a motivation is further evident when viewing Downing as a whole. As previously explained, Downing does NOT in anyway teach a mechanism for providing ATM cards to the recipient of a money transfer transaction. In fact, the goal of Downing is to provide for money transfers without the use of an ATM card by the recipient.

Schenck v. Nortron Corp., provides a good example where the differences in the prior art and the claimed invention as a whole demonstrate the non-obviousness of the claimed invention. *Nortron* argued the invention is just making integral what had been made in four bolted pieces,

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 10 of 17

improperly limiting the focus to a structural difference from the prior art and failing to consider the invention as a whole. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.). Such is the case here, where the goal of the Downing reference is to provide for cardless withdrawal of cash. The claimed invention, utilizing a standard ATM card, is contrary to the understandings and expectation of the prior art as demonstrated by Downing.

Moreover, the Examiner has not considered teachings in Downing that lead away from the claimed invention. Downing clearly states that its goal is to provide for cardless withdrawal of cash, which is "implemented more easily" with modified ATM machines. This teaching, which is indeed the principle teaching of the reference, leads away from the claimed invention.

As acknowledged by the Examiner and clear from the reference, Downing fails to teach use of a standard ATM card. To provide the teachings related to the standard ATM card, the Examiner looks to Picciallo. Further, in order to combine the cardless system of Downing as suggested by the Examiner, one of ordinary skill in the art would have had to determine how to combine the cardless system of Downing with the smart card system of Picciallo to use at standard ATMs. While Picciallo mentions ATM machines in passing (see *Picciallo* at col. 11, lines 35-44), Picciallo does not provide any detail as to how the smart card is used within the ATM network. Downing also mentions in passing that the invention, although not the preferred mode, could be adapted for use with conventional ATMs. However, Downing, like Picciallo, provides no teaching as to how this could be accomplished. The preferred embodiment, and

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 11 of 17

indeed all disclosed embodiments, of Downing relate solely to Customer Activated Terminals (CATs), which is a specially modified ATM made by the assignee, Citicorp. *Downing* at col. 4, lines 47-60. There is no disclosure as to how the invention of Downing could be adapted for use in standard ATMs. Picciallo provides no help as to how this might be accomplished. As such, there is no reasonable likelihood that one of ordinary skill in the art would have succeeded in combining Downing and Picciallo in the manner suggested by the Examiner.

For the reasons stated above, Applicant asserts that the group 1 claims are nonobvious in view of Downing and Picciallo.

2. ISSUE B: Group 2 (claims 60, 71, and 74) are non-obvious in view of Downing, Picciallo, and Itoh.

Claim 60 recites in relevant part:

determining whether said recipient receives said standard atm card; and if said recipient does not receive said standard atm card, providing a monetary credit to said sender.

Claims 60, 71, and 74 are non-obvious for the same reasons as stated with respect to the claims of Group 1 and the additional reasons stated below.

Ito focuses on the transfer of the electronic money, not the IC card which is presumed to already be in the recipient's possession. Thus, Ito at best teaches determination of receipt of the funds, NOT the standard atm card as recited in the group 2 claims.

Additionally, Ito fails to teach determining whether the recipient receives the electronic money and, if not, providing a monetary credit to the sender. Ito only teaches providing a refund after "a certain period of time passes." *Ito* at col. 2, lines 42-47; col. 5, line 65 to col. 6, line 3. There is a no direct relationship between the receipt of the electronic money and the granting of a refund. Rather, Ito determines failure to receive the electronic money after a set period of time.

Lastly, as to the motivation to combine the references, the Examiner states that "[f]or example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender." Office Action dated November 8, 2004 at p.5. However, it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 12 of 17

conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.")

Moreover, Applicant asserts that this was not well known at the time within the context of secure money transfer. The Applicant challenges the Examiner to find such a teaching within the analogous art. 37 CFR §1.104(c)(2); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test).

For the reasons stated above, Applicant asserts that the group 2 claims are nonobvious in view of Downing, Picciallo, and Itoh.

3. ISSUE C: Group 3 (claims 62-66) are non-obvious in view of Downing, Picciallo, and Corder.

Claim 62 recites in relevant part:

wherein said requestor may allocate additional money to said standard atm card via a communications network.

Claims 62-66 are non-obvious for the same reasons as stated with respect to the claims of Group 1 and the additional reasons stated below.

Lastly, as to the motivation to combine the references, the Examiner fails to identify any motivation to combine Corder with the other references. As such, the Examiner has failed to establish the first criteria required for *prima facie* obviousness.

For the reasons stated above, Applicant asserts that the group 3 claims are nonobvious in view of Downing, Picciallo, and Corder.

4. Group 4 (claims 67) are non-obvious in view of Downing, Picciallo, Itoh, and Corder.

Claim 67 is non-obvious for the same reasons as stated with respect to the claims of Group 1, Group 2, and Group 3. For these reasons, Applicant asserts that the group 4 claim is nonobvious in view of Downing, Picciallo, Itoh, and Corder.

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 13 of 17

VIV. CONCLUSION

For the reasons set forth above, Applicant requests that the Board overturn the Examiner's rejections and pass the claims to issue.

If any matters can be resolved by telephone, Applicant requests that the Patent and Trademark Office call the Applicant's attorney at the telephone number listed below.

Respectfully submitted,

DATE: June 10, 2005

Mitchell S. Rosenfeld/
Mitchell Rosenfeld
Reg. No: 36,258

Correspondence Address:
Rosenfeld Law Corporation
2165 Filbert Street, Suite 200
San Francisco, CA 94123
Customer No. 31955
(415) 928-3853

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 14 of 17

APPENDIX

LISTING OF CLAIMS

1. – 58. (Cancelled)

59. (Previously presented) An automated process for sending money from a first location to a second location comprising:

receiving a request for a secure money transfer from a requestor;
receiving information associated with a recipient for said secure money transfer;
receiving information indicating an amount of said secure money transfer;
transferring said amount to a standard atm card;
assigning an access code to said standard atm card;
providing said standard atm card to said recipient; and
providing said access code from said requestor to said recipient;

wherein said standard atm card is a card for use in existing automated teller machines;
and

whereby said standard atm card and said access code enable said recipient to use said standard atm card in said automated teller machines.

60. (Previously presented) The process of claim 59 further comprising the steps of:

determining whether said recipient receives said standard atm card; and
if said recipient does not receive said standard atm card, providing a monetary credit to said sender.

61. (Previously presented) The process of claim 59,

wherein said receiving information includes a delivery address personal to said recipient;
and

wherein the step of providing said standard atm card to said recipient provides said standard atm card at said delivery address personal to said recipient.

62. (Previously presented) The process of claim 59, wherein said standard atm card is used to transfer money from said requestor located in a first country to said recipient located in a second

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 15 of 17

country, and wherein said requestor may allocate additional money to said standard atm card via a communications network.

63. (Previously presented) The process of claim 62, wherein said amount is provided by said requestor in a first currency and provided to said recipient in second currency, wherein said first currency and said second currency are of different nationalities.

64. (Previously presented) An automated process for sending money from a first location to a second location comprising:

receiving a request for a secure money transfer from a requestor indicating a destination for said transfer and an amount for transfer via a communications network;

assigning said amount to a standard atm card;

assigning an access code to said standard atm card;

providing said access code from said requestor to said recipient;

providing said standard atm card to said destination such that a recipient receives said standard atm card enabling said recipient to withdraw funds from an automated teller machine using said standard atm card and said access code, wherein additional amounts may be assigned to said standard atm card by said requestor for retrieval by said recipient.

65. (Previously presented) The process of claim 64 further comprising:

receiving an additional request from said requestor via said communications network indicating a sum of money to be added to said standard atm card for retrieval by said recipient using said standard atm card.

66. (Previously presented) The process of claim 64 wherein said destination is an address personal to said recipient.

67. (Previously presented) The process of claim 64 further comprising the steps of:

determining whether said recipient receives said standard atm card; and

if said recipient does not receive said standard atm card, providing a monetary credit to said requestor.

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appeal Brief (amended)
Page 16 of 17

68. (Previously presented) An automatic money transfer system for transferring money from a donor to a donee comprising:

an automated server system for facilitating the secure transfer of money from a donor to a donee, said automated server system being operative to allocate funds to a standard atm card and to assign a security code to said instrument, said standard atm card including machine readable information;

a data storage device for recording said secure transfer; and

a delivery system for providing said standard atm card to said donee enabling said donee to access said funds from an existing automated teller machine using said standard atm card and said security code;

wherein said donor provides the security code to the donee.

69. (Previously presented) The system of claim 68 wherein said security code is contained in said machine readable information.

70. (Previously presented) The system of claim 68 wherein said security code must be manually entered on said automated teller machine by said donee in order for said donee to receive money.

71. (Previously presented) The system of claim 68 further comprising:

means for determining whether said donee receives said standard atm card; and

means for providing a monetary credit to said donor if said donee does not receive said standard atm card.

72. (Previously presented) The system of claim 68 further comprising:

a data storage device for storing a delivery address personal to said donee; and

wherein said delivery system is configured for proving said standard atm card to said donee at said delivery address personal to said donee.

Application No. 10/716,637
Attorney Docket No. JDC-002-US
Applicant's Appcal Brief (amended)
Page 17 of 17

73. (Previously presented) An automated process for sending money from a first location to a second location comprising:

receiving a request for a secure money transfer from a requestor;
receiving information associated with a recipient for said secure money transfer;
receiving information indicating an amount of said secure money transfer;
transferring said amount to a standard atm card;
assigning an access code to said standard atm card;
providing said standard atm card to said recipient at an address personal to said recipient;
and
providing said access code to said recipient;
wherein said standard atm card is a card for use in existing automated teller machines;
and
whereby said standard atm card and said access code enable said recipient to use said standard atm card in said automated teller machines.

74. (Previously presented) The process of claim 73 further comprising the steps of:

determining whether said recipient receives said standard atm card; and
if said recipient does not receive said standard atm card, providing a monetary credit to said sender.

75. (Previously presented) The process of claim 73, wherein said access code is provided to said recipient by said sender.